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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,512	12/22/2000	Wenyu Han	Zebex 3A	1744

7590 06/02/2004  
HENRY I SCHANZER, ESQ.  
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EDISON, NJ 08817

EXAMINER

LEE, SEUNG H

ART UNIT PAPER NUMBER

2876

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/745,512

Applicant(s)

HAN ET AL.

Examiner

Seung H Lee

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Receipt is acknowledged of the response filed on 09 February 2004, which has been entered in the file.

***Claim Objections***

2. Claims 12-19 and 30-31 are objected to because of the following informalities:

Re claim 12, line 1: The phrase "the counterfeiting of an instrument" lacks proper antecedent basis.

Appropriate correction is required.

***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the step of forming the optical pattern occurs simultaneously with the step of writing data must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Brindze et al. (US 5,822,291, of record)(hereinafter referred to as 'Brindze').

Brindze teaches that an optical disk (22) comprising a unique serial number (24) and a read/write serial code (24') encoded in the inner annular region of the disk wherein the serial number and the read/write serial code are in form of barcode serving as a multiplicity of strands, the serial numbers are produced by laser-etching method, main storage area of disk (224) (see Figs. 1A; col. 3, line 3, line 20- col. 4, line 33).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made:

7. Claims 13-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brindze in view of Bejerano et al. (US 4,270,153, of record)(hereinafter referred to as "Bejerano").

The teachings of Brindze have been discussed above.

In addition to the teachings of Brindze as discussed above, he also teaches the serial numbers are produced by laser-etching method using laser etcher (316), a main storage area of disk (224), scanning the serial number for identifying purposes, the serial code including a serial number, status and accounting information wherein such information is verified in order to access the content of disk storage medium, and the serial number (24) is alterable for indicating for recording status information and the read/write code can be overwritten for indicating current authorization status of the CD in which such altering and/or overwriting code occurs same time the data content is read/written, the serial code is located between the top and the bottom surface (see Figs. 3, 4, 5, 10-13; Abstract; col. 9, line 50- col. 15, line 44).

However, Brindze fails to particularly teach that the first region of the disk is translucent.

Bejerano teaches that the optical disk is essentially transparent or translucent and forming an opaque stripe (see Fig. 6; col. 2, lines 32-51; col. 5, line 57- col. 6, line 51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bejerano to the teachings of Brindze in order to provide an improved means for increasing the readability by transmitting light beam using the translucent or transparent optical disk. Moreover, such modification (i.e., using opaque material as strand) is well known in the art as shown by Bejerano and it would have been an obvious design variation well within the ordinary skill in the art, failing to provide any unexpected results, for representing the information on recording medium such as the optical disk, and therefore an obvious expedient.

### ***Response to Arguments***

8. Applicant's arguments filed 09 February 2004 have been fully considered but they are not persuasive.

In response to applicant argument that "*Forming a random pattern is not shown, taught or suggested in Brindze et al.*" (page 11, line 11+), the Examiner respectfully disagrees with the applicant wherein the serial code (e.g. barcodes) of Brindze is unique to each copy of the CD in which each barcodes comprises a plurality of single randomly generated barcode storing information therewith. Accordingly, given its broadest reasonable interpretation, the teachings of Brindze meet the claimed limitations.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

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(i.e., the random pattern formed on an instrument and storing the pattern in a remote data base) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (703) 308-

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5894. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

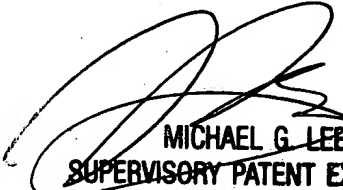
If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax-phone number for this group is (703) 308-5841 or (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.lee@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

  
Seung H. Lee  
Art Unit 2876  
May 27, 2004

  
MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
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